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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/985,679	11/05/2001	Russell Michael Hagan	2801-0165P	4024

2292 7590 08/26/2003

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EXAMINER

TRAVERS, RUSSELL S

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/985,679

Applicant(s)

Hagan et al

Examiner

R.S. Travers J.D., Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 11, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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The amendment and request for interference filed April 29, 2002 have been received and entered into the file.

Applicant's arguments filed April 29, 2002 have been fully considered but they are not deemed to be persuasive.

Claims 1-25 are presented for examination.

The Office Action filed April 5, 2002 is hereby withdrawn. The following Official Office action is hereby presented.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, and thereby failing to provide an enabling disclosure.

The instant specification fails to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation. Attention is directed to *In re Wands*, 8 USPQ2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdAplis 1986) at 547 the court recited eight factors:

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- 1) the quantity of experimentation necessary,
- 2) the amount of direction or guidance provided,
- 3) the presence of absence of working examples,
- 4) the nature of the invention,
- 5) the state of the prior art,
- 6) the relative skill of those in the art
- 7) the predictability of the art, and
- 8) the breadth of the claims.

Applicant fails to set forth the criteria that defines those compounds useful as NK₁ antagonists, or 5HT₃ antagonists. Additionally, Applicant fails to provide information allowing the skilled artisan to ascertain these compounds without undue experimentation. In the instant case, only a limited number of NK₁ antagonist, or 5HT₃ antagonist examples are set forth, thereby failing to provide sufficient working examples. It is noted that these examples are neither exhaustive, nor define the class of compounds required. The pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. The instant claims read on all NK₁ antagonists, or 5HT₃ antagonists, necessitating an exhaustive search for the embodiments suitable to practice the claimed invention. Applicants fail to provide information sufficient to practice the claimed invention, absent undue experimentation. In the present case, Applicants are claiming any compound

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functionally possessing the envisioned activity, by claiming those compounds falling under that functional penumbra encompassed by the functional language employed; yet fail to provide a specification that enables, or suggests those actual compounds useful to practice the invention as claimed. Absent guidance the presented claims a simply an invitation to experiment placed on those attempting to practice the instant invention as claimed.

Claims 1-25 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 1-25 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-25 are rendered indefinite by the phrases NK₁ antagonists, or 5HT₃ antagonists and thereby failing to clearly set forth the metes and bounds of the patent protection desired. Criteria defining that broad spectrum of medicaments that are useful as NK₁ antagonists, or 5HT₃ antagonists are not set forth in the specification, thereby failing to provide information defining the instant inventions metes and bounds. By employing wholly functional language to define those compounds useful for practicing the claimed invention, Applicant's have failed to establish the metes and

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bounds for the envisioned invention. Inclusive examples of what a NK_1 antagonist, or a $5HT_3$ antagonist would be are not set forth in the specification. Absent such exemplification, the skilled artisan could not establish the identity of compounds that were useful as a NK_1 antagonist, or a $5HT_3$ antagonist. Applicant's phrases fail to clearly define the subject matter encompassed by the instant claims, thus is properly rejected under 35 USC 112, second paragraph. All compounds, existing, envisioned, or undiscovered, possessing the NK_1 antagonist, or a $5HT_3$ antagonist activity are encompassed by the claims herein presented. Absent limitations more clearly setting forth that subject matter envisioned, or a more detailed specification illustrating that subject matter envisioned, the instant claims fail to set forth identifiable metes and bounds to practice the instant invention. Thus, claims 1-25 are properly rejected under 35 USC 112, second paragraph.

No claims are allowed.

Any inquiry concerning this communication should be directed to Russell Travers at telephone number (703) 308-4603.



Russell Travers J.D., Ph.D.
Primary Examiner
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